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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER BERNHARD KAARS

Appeal 2008-3994
Application 09/900,335
Technology Center 2400

Decided:¹ March 30, 2009

Before LEE E. BARRETT, ST. JOHN COURTENAY III, and
THU A. DANG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-11. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellant's invention relates to sending or distributing electronic content over a data network. More particularly, Appellant's invention is directed to e-mail communications. (Spec. para. [001]).

Independent claim 1 is illustrative:

1. A method of controlling communication of content information from a sender to a receiver via a data network, comprising:

verifying with a plurality of sources throughout the data network whether the content information is available from at least one of the sources other than the sender;

contacting a search engine if the content information is available from the at least one source, wherein the search engine determines a location within the data network of the at least one source of the content information and returns an updateable index listing each of the sources of a copy of content information; and

substituting for the content information a pointer to the location of the at least one source based on the updateable index of sources returned by the search engine.

Prior Art

Zabetian	US 6,327,656 B2	Dec. 4, 2001
Jones	US 2002/0188841	Dec. 12, 2002

Examiner's Rejections

1. Claims 1-3 and 7-11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Jones.
2. Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones in view of Zabetian.

Claim Groupings

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal on the basis of claims 1 and 4. *See* 37 C.F.R. § 41.37(c)(1)(vii).

APPELLANT'S CONTENTIONS

Appellant contends that Jones fails to disclose verifying with a plurality of sources throughout the data network whether the content information is available from at least one of the sources other than the sender, as recited in claim 1. (App. Br. 6).

Appellant contends that Jones fails to disclose the limitation of substituting for the content information a pointer to the location of the at least one source based on the updateable index of sources returned to the search engine. (Reply Br. 3).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues flow from the Appellant's contentions and the Examiner's findings:

1. Has Appellant shown that the Examiner erred in determining that Jones discloses verifying with a plurality of sources throughout the data network whether the content information is available from at least one of the sources other than the sender?
2. Has Appellant shown that the Examiner erred in determining that Jones discloses substituting for the content information a pointer to the location of the at least one source based on the updateable index of sources returned to the search engine?

PRINCIPLES OF LAW

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Claim Construction

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading

disclosed limitations into the claim. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

Anticipation

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. However, this is not an “ipsissimis verbis” test. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

Obviousness

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007).

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF) that are supported by a preponderance of the evidence:

Jones

1. Jones discloses a watermark detector that may be used to extract a watermark bearing a content identifier, and possibly content type

tags that are used as input for a search to find related content or information about the content. (Para. [0038]).

2. Jones discloses that a web searching agent reports back to a searchable database. (Para. [0042]).

3. Jones discloses that the searchable database is accessed by the search engine. (Para. [0043]).

4. Jones discloses a context index that has a searchable index of key words and content tags that are associated with file pointers of files that match the description of the key words/content tags. (Para. [0042]).

5. Jones discloses that file pointers provide the location of the corresponding files on the computer network. (*Id.*).

ANALYSIS

Anticipation rejection of claims 1-3 and 7-11

We consider the Examiner's rejection of claim 1 as being anticipated by Jones.

Issue 1

As discussed above, Appellant contends that Jones fails to disclose verifying whether the content information is available from at least one source *other than the sender*. (Emphasis added). Appellant contends that Jones describes that the sources that are searched are the senders of the content, thereby teaching away from the invention as claimed. (App. Br. 7).

We find Appellant’s “teaching away” argument is misplaced, because the Examiner has rejected the claims under 35 U.S.C. § 102. Our reviewing court has determined that “[t]eaching away is irrelevant to anticipation.” *Seachange International, Inc., v. C-Cor, Inc.*, 413 F.3d 1361, 1380 (Fed. Cir. 2005).

We note that claim 1 requires a verification that “the content information is available from at least one of the sources other than the sender,” and no other functions/steps are recited within the claimed “verifying step.” We further note that the watermarks described in Jones perform the claimed verification step by searching a plurality of sources, (i.e., other networks and/or domains as well as the eventual source). (*See* FF 1). Thus, it is our view that according to Jones, there are several sources that have the desired content, apart from the *eventual* source (sender) of the desired content (i.e., a source other than the sender).

Appellant further contends that because Jones fails to disclose verifying a source other than the sender, that Jones also fails to disclose the conditional step of contacting a search engine *if* the content is available from the at least one source. (App. Br. 8). We disagree, because as stated above, Jones does in fact verify that the content is available from a source other than the eventual sender of the content. Thus, Jones discloses that the search engine is contacted after the searchable database is queried. (FF 2-3). The eventual source of the content is returned as a result of the query. (FF 4). Thus, we find that Jones discloses the conditional step of contacting the search engine if the content information is available from the at least one source.

Issue 2

As stated above, Appellant contends that Jones fails to disclose substituting for the content information a pointer to the location of the at least one source based on the updateable index of sources returned to the search engine. More specifically, Appellant argues that there is no substitution of the content with a pointer to the location of the at least one source. (Reply Br. 3)

We note that Jones teaches the use of file pointers (FF 5). However, we find that the claimed pointer is not positively recited in the claim as being used to access content information, or any other information. Thus, we find Appellant's argument unpersuasive regarding the claimed pointer because Appellant's argument would require us to give patentable weight to nonfunctional descriptive material (i.e., a pointer that performs no function as claimed). The content of nonfunctional descriptive material is not entitled to weight in the patentability analysis. *Cf. In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) ("Lowry does not claim merely the information content of a memory. . . . Nor does he seek to patent the content of information resident in a database."). *See also Ex parte Nehls* (BPAI Jan. 28, 2008), available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071823.pdf>; *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Fed. Cir. Appeal No. 2006-1003, aff'd Rule 36 Jun. 12, 2006); Manual of Patent Examining Procedure (MPEP) § 2106.01 (Eighth ed., Rev. 7, July 2008).

For at least the aforementioned reasons, we find Appellant has not shown that the Examiner erred in rejecting representative claim 1. Accordingly, we sustain the Examiner's rejection of claims 1-3 and 7-11 as being anticipated by Jones.

Obviousness rejection of claims 4-6

We next consider the Examiner's rejection of claims 4-6 as being unpatentable over Jones and Zabetian. We note that Appellant's arguments essentially state that claims 4-6 are allowable based on their dependence from claim 1. (App. Br. 10-11). Thus, Appellant urges the patentability of claims 4-6 based on the arguments we found unpersuasive regarding claim 1, as previously discussed. Accordingly, we find that Appellant has not shown that the Examiner erred in rejecting claims 4-6. We sustain the Examiner's rejection of claims 4-6 as being unpatentable over Jones and Zabetian.

REPLY BRIEF

We note that the Reply Brief should be used to respond to points of argument raised by the Examiner in the Answer and not as a means for presenting new arguments. *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (an issue not raised in an opening brief is waived). While we have fully considered Appellant's responses in the Reply Brief, we decline to address any new arguments not originally presented in the principal Brief. With respect to all claims before us on

appeal, arguments which Appellant could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

CONCLUSION

Appellant has not shown that the Examiner erred in determining that Jones discloses verifying with a plurality of sources throughout the data network whether the content information is available from at least one of the sources other than the sender.

Appellant has not shown that the Examiner erred in determining that Jones discloses substituting for the content information a pointer to the location of the at least one source based on the updateable index of sources returned to the search engine.

DECISION

The Examiner's rejection of claims 1-3 and 7-11 under 35 U.S.C. § 102(e) is affirmed.

The Examiner's rejection of claim 4-6 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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